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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,397	11/14/2003	James Danial Theall	MDIA-001/00US	6847
7590	10/05/2005		EXAMINER HUYNH, CONG LAC T	
Cooley Godward LLP ATTN: Patent Group One Freedom Square, Reston Town Center 11951 Freedom Drive Reston, VA 20190-5656			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 10/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/712,397

Applicant(s)

THEALL ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/8/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: the application filed on 11/14/03, and the IDSs filed on 4/8/04.
2. Claims 1-29 are pending in the case. Claims 1, 4, 9, 12, 17, 20-21, 26 and 27 are independent claims.

#### ***Drawings***

3. Figures 4-5, 7-11 are objected to since they are not legible.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 17, it is not clear why performing step "inputting a keyword" since there is no connection of said inputting step with the other steps in the claim. It appears that there is no need of the inputting step in the claimed method.

Regarding claim 18, which is it is unclear why "selecting a slide from a slide show" (line 4) since this feature is disclosed in claim 17 "selecting at least one of a slide and a

sequence of slides from the list" (line 6). It appears that the selecting step in claim 18 is redundant.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-17, 20-29 are rejected under 35 U.S.C. 102(a) as being anticipated by Brown (US Pat App Pub No 2003/0160814 A1, 8/28/03, filed 2/27/02).

Regarding independent claim 1, Brown discloses:

- identifying an existing slide show ([0025]: selecting a particular slide show presentation from the electronic slide show implies that said particular slide show is identified)
- selecting a slide of the existing slide show ([0025])
- associating metadata with the selected slide (figure 6, [0035]: the pop-up text with additional information concerning the displayed slide shows associating metadata with the selected slide)

Regarding claim 2, which is dependent on claim 1, Brown discloses

- identifying the slide based on the metadata ([0040], [0035]: the fact that a user can *elect to learn about only those catalogued items of interest via the pop-up text window* which provides details concerning a displayed slide implies that the details associated with a slide, which is equivalent to the metadata, can be used to identify a slide)
- creating a new presentation using the identified slide ([0023], [0025]: a small subset of slides is selected and stored in memory for creating a new presentation)

Regarding claim 3, which is dependent on claim 1, Brown discloses that the metadata includes at least one of sequence information and a story matrix element ([0035]: the details concerning an artist's biography associated with a selected slide is considered a story matrix element).

Regarding independent claim 4, Brown discloses:

- identifying an existing document ([0025]: selecting a particular slide show presentation from the electronic slide show implies that said particular slide show is identified where a slide show is considered equivalent a document)
- selecting a portion of the existing document ([0025]: selecting a slide of the existing slide show)
- associating metadata with the selected portion of the existing document, wherein the metadata includes sequence information (figure 8, [0037]: providing a

thumbnail sketch of a sequence of related slides where the thumbnail sketch is displayed above the currently displayed slides shows associating metadata including sequence information with the selected slide)

Regarding claim 5, which is dependent on claim 4, Brown discloses identifying includes searching documents in at least one of a local database and a remote database ([0031]: retrieving a slide from a system to be displayed implies searching a slide, which is equivalent to a document, in a local database).

Regarding claim 6, which is dependent on claim 4, Brown discloses that identifying is based on at least one of creation date and file name ([0033]: displaying a selected slide based on the slide number shows identifying based on the slide number, which is considered equivalent to a file name since the number is the name of a slide).

Regarding claim 7, which is dependent on claim 4, Brown discloses that selecting a portion of the document includes selecting at least one of a plurality of slides in a slide show ([0025]).

Regarding claim 8, which is dependent on claim 4, Brown discloses:

- associating the selected portion of the document with at least one other selected portion of the document [0025]: the selected slide and the associated slides are managed to be displayed according to user event)

- ordering the selected portion with respect to each of the at least one other selected portion ([0026]: displaying one slide after the other shows ordering)

Regarding independent claim 9, Brown discloses:

- identifying an existing document ([0025]: selecting a particular slide show presentation from the electronic slide show implies that said particular slide show is identified where a slide show is considered equivalent a document)
- selecting a portion of the existing document ([0025]: selecting a slide of the existing slide show)
- associating metadata with the selected portion of the existing document, wherein the metadata includes at least one story matrix element (([0035]: the details concerning an artist's biography associated with a selected slide is considered the metadata of a story matrix element)

Regarding claim 10, which is dependent on claim 9, Brown discloses associating at least one of a theme, an act, and a scene with the selected portion ([0031], figure 4: the slide regarding Venice shows associating of a theme with a selected portion, which is a selected slide).

Regarding claim 11, which is dependent on claim 9, Brown discloses associating each of a theme, an act, and a scene with the selected portion ([0031], figure 4: the slide regarding Venice shows associating of a theme, which is Venice, with a selected

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portion, which is a selected slide, also shows associating of a selected venue, which is equivalent to an act and a scene, to the selected slide).

Claims 12-15 are for a machine readable medium for method claims 4-8, and are rejected under the same rationale.

Claims 12, 15, 16 are for a machine readable medium for performing method claims 9-11, and are rejected under the same rationale.

Regarding independent claim 17, Brown discloses:

- inputting a keyword ([0031]: selecting a venue of Venice, implies the keyword regarding Venice is inputted in the system via the link clicking)
- retrieving a list having at least one of a slide and a sequence of slides, the sequence of slides being defined by a group of individual slides, each of the individual slides having an order with respect to each of the other individual slides in the group ([0031], [0025]-[0026])
- selecting at least one of a slide and a sequence of slides from the list ([0025]-[0026])

Claim 20 is for a machine readable medium for method claim 17, and is rejected under the same rationale.



Regarding independent claim 21, Brown discloses creating a slide show ([0023]), comprising selecting a plurality of pre-existing slides based on at least one of a theme, an act, and a scene ([0024]: a plurality of pre-existing slides is selected based on a theme as automobiles of Mercedes Benz, or Porsche; [0031]: a plurality of pre-existing slides is selected based on a theme as the city of Venice).

Regarding claim 22, which is dependent on claim 21, Brown discloses:-

- displaying a list of a plurality of themes ([0024]: displaying a plurality of pre-existing slides of a plurality of themes as automobiles of Mercedes Benz, and Porsche; [0031], figure 4: displaying a plurality of pre-existing slides of plurality of themes of cities in the world)
- receiving a theme selection from a user, the theme selection identifying at least one of the plurality of themes ([0024]: a plurality of pre-existing slides is selected based on a theme as automobiles of Mercedes Benz, or Porsche; [0031]: a plurality of pre-existing slides is selected based on a theme as the city of Venice)

Regarding claim 23, which is dependent on claim 21, Brown discloses:

- displaying a list of a plurality of acts ([0026]: the ordering of the slides is displayed where "acts relate to the ordering of the slide information as explained in the specification of the claimed invention [0053])
- receiving an act selection from a user, the act selection identifying at least one of the plurality of acts ([0026]: user performs an operation to instruct a slide to

advance when displaying a predetermined sequence of slides shows an act selection by a user)

Regarding claim 24, which is dependent on claim 23, Brown discloses:

- displaying a list of a plurality of scenes ([0025]: selecting a slide of the existing slide show implies that a list of a plurality of slides is displayed for selecting where each slide is a part, which is a scene, of the slide show)
- receiving a scene selection from a user, the scene selection identifying at least one of the plurality of scenes ([0025]: selecting a slide by user and the selected slide is identified)

Regarding claim 25, which is dependent on claim 24, Brown discloses displaying the slide information, the slide information associated with the scene selection ([0035]: the information of the selected slide is displayed where the selected slide is a scene selection).

Claim 26 is a machine readable medium of method claim 21, and is rejected under the same rationale.

Claim 27 is for a system of method claims 4-5, and is rejected under the same rationale.

Regarding claim 28, which is dependent on claim 27, Brown discloses:

- a data link selectively coupled to the workstation (figure 4)

- a server coupled to the data link, the server configured to perform at least one of a storage function and a collaboration function (figure 4, [0014], [0021])

Regarding claim 29, Brown discloses that the workstation further including a synchronization component coupled to the data access component, the synchronization component facilitating data transfer from the workstation to the server when the workstation is coupled to the data link.(figure 4, [0021]).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown as applied to claim 17 above, and further in view of Herberger et al. (US Pat App Pub No. 2005/0084232 A1, 4/21/05, filed 10/16/03).

Regarding claim 18, which is dependent on claim 17, Brown does not disclose:

- selecting a design template
- selecting a slide from a slide show
- determining whether the selected slide is formatted in accordance with the selected design template
- editing a format of the selected slide where it is determined that the selected slide is not formatted in accordance with the selected design template

Herberger discloses:

- selecting a design template (figure 2, #205-229)
- selecting a media data ([0037]: placing digital media into the selected template implies that the media data is selected for placing; [0040]: the video is inputted to the template by user implies that the video is selected for inputting; [0044]: data is inputted into a given template implies that the data is selected for inputting)
- determining whether the selected media data is formatted in accordance with the selected design template ([0037]: determining if the input video clips matches the template location; [0044]: checking on the sort of information that the user is allowed to assign to each template location shows a determination of the accordance of the input data format and the template format)

- editing a format of the selected media data where it is determined that the selected media data is not formatted in accordance with the selected design template ([0044]: resize the selected digital image file to fit within the confines and aspect ratio of a video frame).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Herberger to apply the selected slide into the design template instead of the selected media data since by analogy, the slide data is also a form of data to be inserted into a selected template.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Herberger into Brown for the following reason. Herberger discloses checking the mismatch between the selected data format and the selected template format and editing the selected data if its format is not in accordance with the selected template format, where the data of the selected slide is equivalent to the media data, providing the advantage to incorporate into Brown for quickly creating a customized slide show with a pre-existing data via simply editing said data to conform a selected template.

Regarding claim 19, which is dependent on claim 18, Brown does not disclose at least one of identifying a vertical slide orientation mismatch, identifying a slide color scheme mismatch, identifying a missing title field mismatch, identifying a blank title field, identifying a title font style mismatch, and identifying a title font size mismatch.

Herberger discloses identifying a data size mismatch ([0044]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Herberger into Brown for the following reason. Herberger discloses identifying the size mismatch of the selected image and the design template, providing the advantage to incorporate into Brown for identifying the mismatch between the size of the input slide data and the required size of slide data in a template for properly inserting the suitable slide data into the template, where the media data can be replaced with the slide data as mentioned in claim 18 above.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Qureshi et al. (US Pat No. 6,084,582, 7/4/00, filed 7/2/97).

Smith et al. (US Pat No.6,473,749 B1, 10/29/02, filed 2/22/00).

Bretschneider et al. (US Pat No. 6,128,629, 10/3/00, filed 1/7/00).

Abrams (US Pat App Pub No.2002/0191013 A1, 12/19/02, filed 6/15/01).

Salesin et al. (US Pat App Pub No.2003/0222890 A1, 12/4/03, filed 5/31/02).

Allen et al. (US Pat App Pub No.2005/0044499 A1, 2/24/05, filed 2/20/04, priority 2/23/03).

Vogel et al. (US Pat App Pub No.2005/0081154 A1, 4/14/05, filed 10/14/03).

Parker et al. (US Pat App Pub No.2003/0231202 A1, 12/18/03, filed 6/18/02).

Businessline, *Speak Visually*, Businessline 6/26/02, pages 1-4 printed from ProQuest.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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